

**Amendments to the Drawings:**

In the Office Action dated June 14, 2005, Figs. 1 and 3 were objected to as failing to provide mentioned reference signs. In response, Figs. 1 and 2 have been amended as redlined in the attached marked up copy. Further, formal Figs. 1 and 2 with the changes indicated herein are attached to replace the original Figs. 1 and 2. In Fig. 1, line A-A has been added, and in Fig. 2, "65" has been replaced by "66". Entry and approval of formal Figs. 1 and 2 is requested.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

## SUMMARY

The present Amendment and following remarks are responsive to the points raised in the June 14, 2005 Office Action. In the Office Action, claims 1-7 and 9-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chou* (U.S. Patent No. 6,017,140) in view of *Johnson et al.* (U.S. Patent No. 4,255,746). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chou* and *Johnson et al.* and further in view of *Schmidt* (U.S. Patent No. 4,290,095). Upon entry of this Amendment, claims 1-15 will remain pending in this application. Entry and consideration of this response are respectfully requested.

## REMARKS

### Rejections Under 35 U.S.C. § 103(a)

Claims 1-7 and 9-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chou* in view of *Johnson et al.* Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chou* and *Johnson et al.* and further in view of *Schmidt*. Since these rejections are based upon the same references, they will be addressed together herein. Applicant traverses this rejection.

Regarding the rejections based upon the combination of *Chou* and *Johnson et al.*, Applicant avers that the claims as written are not taught or suggested by the combination of these two references since any resulting combination would not provide all elements as claimed herein. Further, Applicant avers that one of ordinary skill in the art, when contemplating amending *Chou*, would neither be aware of, nor have the knowledge to search for, the *Johnson et al.* reference. The claims as pending in the current application provide a safety light and a method of operating the safety light. For example, claim 1 provides a safety light with a sensor that “switches the safety light from operation of the primary bulb to operation of the at least one LED

“bulb” when the sensor determines that the available power is inadequate to supply power to the primary bulb. Neither *Chou, Johnson et al.*, or the combination of *Chou* and *Johnson et al.* provides such functionality. Specifically, the Examiner states in the Office Action that:

*Chou* shows the invention substantially as claimed except for a sensor which determines if the available power is inadequate to supply the first power, and the sensor switches the safety light from operation of the primary bulb to operation of the at least one LED bulb.

Applicant agrees that *Chou* fails to provide a sensor or the operation of such a sensor.

The Examiner then avers that the *Johnson et al.* reference provides a safety unit circuitry and cites as support column 4, lines 23-37 as repeated here:

To assure that sufficient energy is always available to operate the fire detector 47, low voltage dropout system 50 is provided. Upon detection that the voltage of battery 46 has dropped below a predetermined level, dropout system 50 causes switch 45 to open, thereby preventing further power drain of battery 46 by auxiliary light 12. In the event emergency light system 44 is activated, the battery will not be discharged below a level capable of supplying the power requirements of detector system 47 for several days. In addition to shutting off light 12, dropout system 50 also pulses switch 48 which activates the audible alarm 49 to produce a continuous intermittent beep. This signal also serves to indicate a wornout or defective battery that will not hold a charge.

As detailed above, *Johnson et al.* provides a low voltage dropout system 50 that determines when the voltage of battery 46 has dropped below a predetermined level and opens a switch 45 to shut off auxiliary light 12. After shutting off light 12, the dropout system 50 then pulses a switch 48 to activate an audible alarm 49 to produce a continuous intermittent beep. However, *Johnson et al.* fails entirely to disclose a sensor that switches a light from operation of a primary bulb to a secondary bulb, and especially fails to disclose at all initiation of an LED bulb. At best, *Johnson et al.* provides a teaching of disengaging entirely a light to activate an audible alarm. Armed with this teaching, one of ordinary skill in the art would be unable to modify the multi-functional bicycle lamp of *Chou* to reach the claimed invention.

Further still, the combination of *Chou* and *Johnson et al.* cannot be performed without undue modification of *Chou*. *Chou* provides a bicycle lamp operated by a switch to allow a user to cycle through several operational modes of the lamp. *Chou* fails entirely to teach or suggest modification of the lamp to provide switching from one mode of operation to another without physical intervention by a user. One of ordinary skill in the art armed with the portable light of *Chou* would not be motivated to look to the non-portable, fire detector system of *Johnson et al.* to reach the claimed invention – especially since the combination of *Chou* and *Johnson* fails to meet all limitations of the claimed invention. Specifically, the Examiner has failed to address how the low voltage dropout system 50 of *Johnson et al.* would be installed and used in the *Chou* lamp. Accordingly, since *Chou* fails to teach or suggest modifying the bicycle lamp provided therein and since all operation of the *Chou* lamp is performed by physical pressing of a switch, one of ordinary skill in the art would not be motivated to combine the *Chou* reference with the *Johnson et al.* reference.

Applicant avers that the *Chou* and *Johnson et al.* references cannot be combined without rendering the prior art (*Chou*) unsatisfactory for its intended purpose or without changing the principal of operation of the *Chou* reference as detailed in MPEP § 2143.01. *Chou* fails entirely to provide for switching automatically from one mode of operation to another, for monitoring battery power, or for switching operation from one mode to another based on input regarding battery power. Further, *Johnson et al.* fails to provide a teaching or suggestion for modifying a bicycle lamp, such as the one shown in *Chou*, to include separate modes of operation. Further still, *Johnson et al.* fails entirely to provide a teaching or suggestion for switching from operation of a primary bulb to a secondary light bulb.

In addition to the above, the Examiner's reasoning in combining *Chou* and *Johnson et al.* also is improper. The Examiner states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the circuitry of Johnson et al. for the multifunctional bicycle lamp of Chou to provide the safety light continuously even though there is insufficient power for the primary light bulb from the power source (e.g. battery). The bicycle rider can easily notice the change of the light or light intensity at night. Therefore, the rider can take some action before the power in the battery becomes totally empty. It is well known in the art that the low power consuming LED bulb (Fig. 2, 18) of Chou can be placed in the position of the audio alarm (Fig. 4, 49) of Johnson et al.

This reasoning is improper and fails to provide a *prima facie* case of obviousness. The Examiner is referred to the Background and Summary of the Invention of the present specification, which cites that one of the purposes of the present invention is to allow the safety lamp to operate without intervention by the user. The Examiner's reasoning improperly cites that "the rider can take some action before the power in the battery becomes totally empty." The Examiner clearly is referring to the fact that operation of the safety lamp of *Chou* requires intervention by the user through the pressing of a switch. A logical following of the reasoning of the Examiner yields that once a bicycle rider notices the change of the light or light intensity at night, the rider could then undertake an action by pressing on the switch of the lamp in *Chou* before power in the battery "becomes totally empty." This is precisely one of the operations that the inventive safety lamp of the present invention addresses.

Even if the proposed combination of *Chou* and *Johnson et al.* were made as suggested by the Examiner, in an attempt to reach the claimed invention, the resulting lamp, as admitted by the Examiner in the teaching, would still require intervention by the user and would still require the user to anticipate that the battery is draining. This lack of sensor operation as claimed and the requirement for intervention by the user provide additional support for the Applicant's position

that the combination of *Chou* and *Johnson et al.* do not teach or suggest any of the present claims. Accordingly, rejections based upon the combinations of *Chou* and *Johnson et al.* should not have been applied initially and should be removed as moot.

As to the rejection of claim 8 based upon the *Chou* and *Johnson et al.* references further in view of *Schmidt*, Applicant avers that claim 8 likewise is allowable as dependent upon allowable claim 1. *Schmidt* fails entirely to make up for the inadequacies of *Chou* and *Johnson et al.* by failing to provide any teaching or suggestion that would enable one of ordinary skill in the art to modify *Chou* and/or *Johnson et al.* to reach the claimed invention.

#### Prima Facie Case Of Obviousness

A prima facie case of obviousness has not been established. As detailed in MPEP § 706.01(j):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In Re Vaeck, 947 F.2d, 488, 20 USPQ2d 14, 38 (Fed. Cir. 1991).

A prima facie case of obviousness has not been established because there is no suggestion or motivation to combine the references. The burden of establishing a prima facie case of obviousness is initially placed on the Examiner and shifts to the Applicant once a case has been established. After the initial assertion of prima facie case of obviousness, if the Applicant then provides evidence that a prima facie case of obviousness does not exist, the burden to prove the existence of a prima facie case of obviousness shifts back to the Examiner. Here, a prima facie

case of obviousness has not been established since the references cited lack a basis upon which the combination can be made as detailed above. Further, even if these references were combined, the claimed invention is not taught or suggested by the combination of references. Any conversion of these applied rejections under 35 U.S.C. § 103(a) to final rejections in response to this Amendment would be improper absent such express suggestion or teaching in the references. Accordingly, the rejections applied should be withdrawn.

### **CONCLUSION**

Claims 1-15 are allowable as written and an early notice of such effect is earnestly solicited. Should the Examiner have any questions or comments regarding the foregoing Amendment, he is invited and urged to telephone the undersigned attorney.

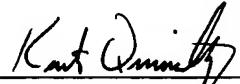
### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Respectfully submitted

10/26/05

Date

  
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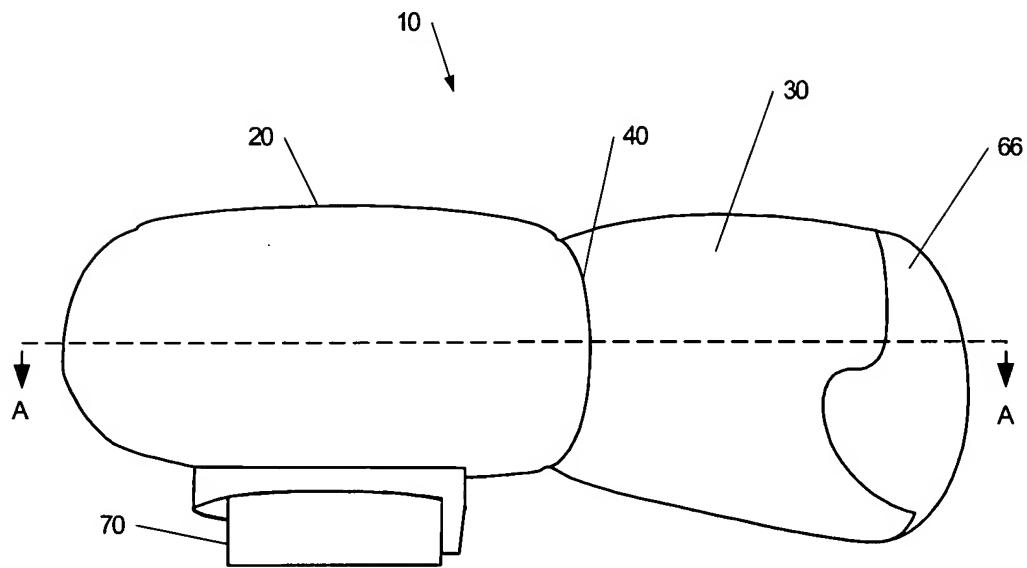


FIG. 1

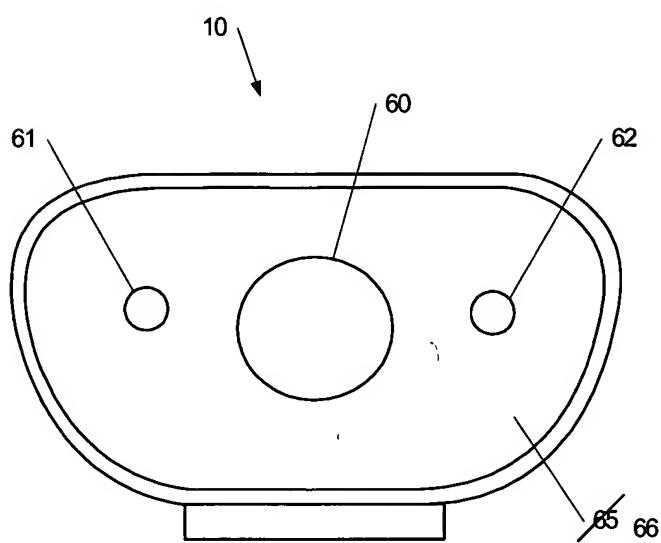


FIG. 2